REMARKS

By this Amendment, Applicants amend claims 1-11 to cure minor informalities and improve form. Claims 1-15 remain pending in this application.

In the Office Action of December 2, 2005,[1] claims 1-3, 6-8, and 11-13 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 2003/0065774 ("*Steiner*"); and claims 4, 5, 9, 10, 14, and 15 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Steiner* in view of U.S. Patent No. 6,327,590 ("*Chidlovskii*"). Applicants address the rejections below.

Section 102(e) Rejection

Applicants traverse the § 102(e) rejection of claims 1-3, 6-8, and 11-13 because *Steiner* fails to anticipate the claims. In order to properly anticipate Applicants' claimed invention under 35 U.S.C. § 102, a single prior art reference must disclose each and every element of the claim at issue, either expressly or under principles of inherency. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *See* M.P.E.P. § 2131. Also, "[t]he elements must be arranged as required by the claim." *Id.*

With regard to claim 1, *Steiner* fails to teach at least "search condition item extracting means" as claimed. *Steiner* is directed to a "distributed resource search mechanism in a peer-to-peer computer network." Abstract. In rejecting claim 1, the Examiner noted *Steiner*'s disclosure regarding receiving a resource query (step 307), finding resource providers (step 308), and sending the resource query to candidate resource providers (step 309). Office Action at p. 2

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[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

(citing *Steiner*, ¶ 0039); *see also Steiner*, Fig. 3. Contrary to the Examiner's position, this disclosure in *Steiner* does not teach the claimed "search condition item extracting means."

According to *Steiner*, "resource providers are the nodes that have access to various resources." *Steiner*, ¶ 0027. Finding an appropriate node having access to a particular resource included in a query and sending the query to that node, as disclosed by *Steiner*, does not constitute ". . . means for extracting at least one of an information item related to the information service retrieved by the temporary search unit and a value of the information item, from the registry and notifying the agent of at least of the information item extracted and the value extracted, together with the result of the search made by the temporary search unit," as recited in claim 1. Obtaining a resource provider having access to a resource is not the same as extracting information items and/or item values registered corresponding to services searched at a temporary search unit. Indeed, neither the relied-upon portion nor any other portion of *Steiner* teaches the claimed "search condition item extracting means."

Because *Steiner* does not teach each and every feature of claim 1, as a matter of law, it cannot anticipate this claim. As such, the § 102(e) rejection of claim 1 based on *Steiner* should be withdrawn. Applicants thus request withdrawal of the § 102(e) rejection and the timely allowance of claim 1.

Claim 2 depends upon claim 1 and is distinguishable from *Steiner* for at least reasons similar to those presented above in connection with claim 1. Further, *Steiner* does not teach at least "search condition item extracting means [that] classifies, by common category, at least one of the information item names and the item values related to the information service retrieved by the temporary search unit and notifies the agent of the result," as recited in claim 2. The Examiner noted *Steiner*'s disclosure regarding delivering search results "directly to the original

requester" or "to the search broker in order to allow caching of the information." Office Action at pp. 2-3 (citing *Steiner*, ¶ 0041). *Steiner's* disclosure of delivering and caching search results does not constitute classifying information item names and/or item values. Indeed, *Steiner* fails to teach "search condition item extracting means [that] classifies . . .," as claimed. Because *Steiner* does not teach each and every feature of claim 2, as a matter of law, it cannot anticipate this claim. As such, the § 102(e) rejection of claim 2 based on *Steiner* should be withdrawn. Applicants thus request withdrawal of the § 102(e) rejection and the timely allowance of claim 3.

Claim 3 depends upon claim 2, which in turn depends upon claim 1. Claim 3 is distinguishable from *Steiner* for at least reasons similar to those presented above in connection with claims 1 and 2.

Additionally, *Steiner* does not teach at least "search condition item extracting means [that] uses ontology trees to classify, by common category, at least one of the information item names and the item values related to the information service retrieved by the temporary search unit," as recited in claim 3. The relied-upon portion of *Steiner* (¶ 0088) describes classifying resources in advance, registering a category list in a broker, and determining which broker registered the category in which the query belongs. This functionality disclosed by *Steiner* does not constitute "search condition item extracting means [that] uses ontology trees to classify, by common category, at least one of the information item names and the item values related to the information service retrieved by the temporary search unit," as claimed. Indeed, *Steiner* fails to teach this claimed feature. Because *Steiner* does not teach each and every feature of claim 3, as a matter of law, it cannot anticipate this claim. The § 102(e) rejection of claim 3 based on *Steiner* should therefore be withdrawn. Accordingly, Applicants request withdrawal of the § 102(e) rejection and the timely allowance of claim 3.

Claims 6-8 were rejected "for the same reasons set forth in the rejection of claims 1-3." Office Action at 3. The § 102(e) rejection of claims 6-8 should be withdrawn for the following reasons.

Independent claim 6, although of different scope than claim 1, recites features similar to those of claim 1. For example, claim 6 recites, *inter alia*, "search condition item extracting means for extracting at least one of an information item related to the information service retrieved by the temporary search unit and a value of the information item from the registry and notifying the agent of at least one of the information item extracted and the value extracted, together with the result of the search made by the temporary search unit." The § 102(e) rejection of claim 6 based on *Steiner* should be withdrawn for at least reasons similar to those presented above in connection with claim 1. The § 102(e) rejection of claims 7 and 8 should be withdrawn as well, since each of those claims depends upon claim 6 and is similarly distinguishable from *Steiner*. Claims 7 and 8, although of different scope than claims 2 and 3, are further distinguishable from *Steiner* for at least reasons similar to those presented above in connection with claims 2 and 3. Accordingly, Applicants request withdrawal of the § 102(e) rejection and the timely allowance of claims 6-8.

Claims 11-13 were rejected "for the same reasons set forth in the rejection of claims 1-3." Office Action at 3. Independent claim 11, although of different scope than claim 1, also recites features similar to those of claim 1. For example, claim 11 recites, *inter alia*, "extracting at least one of an information item related to the information service retrieved in the first step and a value of the information item from the registry and notifying the agent of at least one of the information item extracted and the value extracted, together with the result of the search in the first step." The § 102(e) rejection of claim 11 based on *Steiner* should be withdrawn for at least

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reasons similar to those presented above in connection with claim 1. The § 102(e) rejection of claims 12 and 13 should be withdrawn as well, since each of those claims depends upon claim 6 and is similarly distinguishable from *Steiner*. Claims 12 and 13, although of different scope than claims 2 and 3, are further distinguishable from *Steiner* for at least reasons similar to those presented above in connection with claims 2 and 3. Applicants thus request withdrawal of the § 102(e) rejection and the timely allowance of claims 11-13.

Section 103(a) Rejection

Applicants traverse the § 103(a) rejection of claims 4, 5, 9, 10, 14, and 15 because a case for *prima facie* obviousness has not been established. As M.P.E.P. § 2142 states, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed. 2001).

Claims 4 and 5 depend upon claim 2, which in turn depends upon claim 1. For at least the reasons presented above, *Steiner* does not teach or suggest each and every element recited in claim 1 or claim 2. In particular, *Steiner* does not teach or suggest at least "search condition item extracting means," as recited in claim 1, and at least "search condition item extracting means [that] classifies," as recited in claim 2. *Steiner* thus does not teach or suggest each and every feature of dependent claims 4 and 5, which require all of the features of claims 1 and 2.

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Chidlovskii does not cure *Steiner*'s deficiencies. *Chidlovskii* describes "a system for ranking search results obtained from an information retrieval system." Abstract. *Chidlovskii*'s system does not include "search condition item extracting means," as recited in claim 1, or "search condition item extracting means [that] classifies," as recited in claim 2. Although, as the Examiner noted, *Chidlovskii* discloses "ranking results by counting the frequency of appearance of the various search terms in the search query," this functionality does not constitute "search condition item extracting means for extracting at least one of an information item related to the information service retrieved by the temporary search unit and a value of the information item from the registry and notifying the agent of at least one of the information item extracted and the value extracted, together with the result of the search made by the temporary search unit," as recited in claim 1 and required by claims 4 and 5. *See* Office Action at pp. 4-5 (citing *Chidlovskii*: col. 1, lines 41-44). *Chidlovskii*'s ranking functionality further fails to disclose or suggest "search condition item extracting means [that] classifies, by common category, at least one of the information item names and the item values related to the information service retrieved by the temporary search unit and notifies the agent of the result," as recited in claim 2 and required by claims 4 and 5.

Accordingly, the applied references, taken alone or in combination, do not teach or suggest each and every element recited in claims 4 and 5. As such, a *prima facie* case of obviousness has not been established with respect to those claims.

Moreover, *prima facie* obviousness has not been established with respect to claims 4 and 5 at least because the requisite motivation to combine *Steiner* and *Chidlovskii* in a manner resulting in Applicants' claimed combination is lacking. According to the Federal Circuit, "virtually all [inventions] are combinations of old elements." *See e.g., In re Rouffet*, 149 F.3d

1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (citations omitted). An examiner may find every element of a claimed invention in the prior art but mere identification is not sufficient to negate patentability. *Id.* The court explained that "the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *Id.*

In addition, determinations of obviousness must be supported by evidence on the record. *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001), 59 USPQ2d 1693, 1696-98 (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by "substantial evidence"). The desire to combine or modify references must be proved with "substantial evidence" that is a result of a "thorough and searching" factual inquiry. *See In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002), 61 USPQ2d 1430, 1433 (quoting *McGinley v. Franklin Sports, Inc.,* 262 F.3d 1339, 1351-52). Additionally, the Federal Circuit has clearly stated that the evidence of a motivation or suggestion to modify a reference must be "clear and particular." *In re Dembicziak,* 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In this case, the Office Action does not show, by "clear and particular" evidence, that a skilled artisan considering *Steiner* and *Chidlovskii*, and not having the benefit of Applicants' disclosure, would have been motivated to modify or combine the references in a manner resulting in Applicants' claimed combination. The Examiner alleged that a skilled artisan would have combined the references "because the more an information item name appears; the assumption is the more vital that item is to the operations of the provider." Office Action at pp. 5-6. This conclusory allegation in the Office Action is not properly supported and does not

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establish a motivation or suggestion for combining the references as alleged or in a manner resulting in the invention defined by Applicants' claims. That an assumption regarding item importance may be made from the number of appearances of an item does not establish a motivation for combining the references as alleged. Even if the alleged assumption could be made from the number of appearances of an information item, the Examiner provides no evidence from the references or from the knowledge available to those skilled in the art showing why a skilled artisan would have combined the references as alleged. The Examiner provides no reasoning or explanation as to why the alleged assumption would motivate a skilled artisan to combine the references. Indeed, the Examiner provides no motivation, other than to attempt to meet the terms of Applicants' claims, for the alleged combination.

As M.P.E.P. § 2143.01 makes clear, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (citations omitted). In this case, the Examiner has not shown that *Steiner* or *Chidlovskii* "suggests the desirability" of the alleged combination.

Applicants submit that the Examiner is impermissibly using teachings of the present application in hindsight to piece together isolated disclosures of the applied references. Examiners, however, may not pick and choose among isolated disclosures in references to defeat patentability of a claimed invention. Such picking and choosing amounts to improper hindsight reconstruction, and is prohibited. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). For at least the foregoing additional reasons, *prima facie* obviousness has not been established with respect to claims 4 and 5.

Because *prima facie* obviousness has not been established, the § 103(a) rejection of claims 4 and 5 should be withdrawn. Applicants therefore request withdrawal of the § 103(a) rejection and the timely allowance of these pending claims.

Claims 9 and 10 were rejected "for the same reasons set forth in the rejection of claims 4 and 5." Office Action at p. 6. A case for *prima facie* obviousness has not been established with respect to claims 9 and 10, as discussed below.

Claims 9 and 10 depend upon claim 7, which in turn depends upon claim 6. For at least the reasons presented above in connection with the § 102 rejection, *Steiner* does not teach or suggest each and every element recited in claim 6 or claim 7. In particular, as explained, *Steiner* does not teach or suggest at least "search condition item extracting means," as recited in claim 6, and at least "search condition item extracting means [that] classifies," as recited in claim 7. *Steiner* thus does not teach or suggest each and every feature of dependent claims 9 and 10, which require all of the features of claims 6 and 7.

Chidlovskii does not cure *Steiner's* deficiencies. For at least reasons similar to those presented above in connection with the § 103(a) rejection of claims 4 and 5, *Chidlovskii* does not teach or suggest at least "search condition item extracting means," as recited in claim 6 and required by dependent claims 9 and 10 or "search condition item extracting means [that] classifies," as recited in claim 7 and required by claims 9 and 10. Accordingly, the applied references, taken alone or in combination, do not teach or suggest each and every element recited in claims 9 and 10.

In addition, for at least the reasons presented above in connection with claims 4 and 5, the requisite motivation to modify or combine the applied references is lacking with respect to claims 9 and 10. As such, a *prima facie* case of obviousness has not been established with

respect to those claims. Because *prima facie* obviousness has not been established, the § 103(a) rejection of claims 9 and 10 should be withdrawn. Applicants therefore request withdrawal of the § 103(a) rejection and the timely allowance of those pending claims.

Claims 14 and 15 were rejected "for the same reasons set forth in the rejection of claims 4 and 5." Office Action at p. 6. Claims 14 and 15 depend upon claim 11. For at least the reasons presented above in connection with the § 102 rejection, *Steiner* does not teach or suggest each and every element recited in claim 11 or claim 12. In particular, *Steiner* does not teach or suggest at least the "extracting" feature of claim 11 and at least the "classifying" feature of claim 12. *Steiner* thus does not teach or suggest each and every feature of dependent claims 14 and 15, which require all of the features of claims 11 and 12.

Chidlovskii does not cure *Steiner*'s deficiencies. For at least reasons similar to those presented above in connection with claims 4 and 5, *Chidlovskii* fails to teach or suggest at least the "extracting" feature recited in claim 11 and required by dependent claims 14 and 15, and at least the "classifying" feature recited in claim 12 and required by claims 14 and 15. Accordingly, the applied references, taken alone or in combination, do not teach or suggest each and every element recited in claims 14 and 15.

In addition, for at least the reasons presented above in connection with claims 4 and 5, the requisite motivation to modify or combine the applied references is lacking with respect to claims 14 and 15. As such, a *prima facie* case of obviousness has not been established with respect to those claims. Because *prima facie* obviousness has not been established, the § 103(a) rejection of claims 14 and 15 should be withdrawn. Applicants therefore request withdrawal of the § 103(a) rejection and the timely allowance of those pending claims.

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Conclusion

Applicants request the reconsideration of this application in view of the foregoing and the timely allowance of pending claims 1-15.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 2, 2006

By:_____
Frank A. Italiano
Reg. No. 53,056

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